

Application Serial No.:
10/646,409

Attorney Docket No.:
SP03-108

REMARKS

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

By virtue of the above amendments, claim 1 is currently amended. All other claims remain as originally filed. No new claim is added.

I. Specification

The Examiner has pointed out in the Detailed Action that the patent number in line 5, page 3 is incorrect. Applicant has amended it to the correct number --6,475,575--.

II. Rejections under 35 U.S.C. § 112

The Examiner has rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended "at a location within" to --by splitting-- in the last row of claim 1. This should obviate the rejection. This amendment is supported by the disclosure of lines 7-11, page 15 of the specification. Thus no new matter is introduced as a result.

III. Rejections under 35 U.S.C. § 103

35 U.S.C. § 103 requires that an invention, to be patentable, must not be obvious over the prior art "at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The landmark case on obviousness was Graham v. John Deere Co., 383 U.S. 1 (1966), which set forth three factors for determining whether an invention is obvious: (i) the scope and content of the prior art; (ii) differences between the prior art and the claims at issue; (iii) the level of ordinary skill in the pertinent art; and (4) objective evidences of non-obviousness such as commercial success, prior skepticism, copying, long felt but unresolved needs, failure of others, etc. All evidences must be considered and given weight in reaching a decision on obviousness under 35 U.S.C. § 103.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1561, 1 USPQ2d 1593, 1594 (Fed. Cir. 1985) cert. denied, 481 U.S. 1052 (1987); Hodosh v. Block Drug, 786 F.2d 1136, 1143, 229 USPQ 182, 188 (Fed. Cir. 1986), Cert. denied, 479 U.S. 827 (1986); Simmons Fastener Corp. v. Illinois Tool Works, 739 F.2d 1573, 1575, 222 USPQ 744, 746 (Fed. Cir. 1984), cert. denied, 471 U.S. 1065 (1985). Moreover, the prior art itself must suggest the desirability and, therefore, obviousness of a modification of a reference or the combination of references to achieve a claimed invention. Hodosh v. Block Drug, 786 F.2d at 1143 n.5, 229 USPQ at 187 n.5; In re Gorden, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

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In making a rejection under 35 U.S.C. § 103(a), the Examiner must establish a prima facie case of obviousness first. Regarding this, the MPEP provides:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The MPEP, Eighth Edition, 2142 (emphasis added).

A proper *prima facie* case of obviousness requires the examiner to satisfy three requirements. First, the prior art relied upon, coupled with knowledge generally available to one of ordinary skill in the art, must contain some suggestion which would have motivated one of ordinary skill to combine references. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the examiner must show that, at the time the invention was made, the proposed modification had a reasonable expectation of success. See *Amgen v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Finally, the combination of references must teach or suggest each and every limitation of the claimed invention. See *In re Wilson*, 424 F.2d 1832, 1385, 165 USPQ 494, 496 (CCPA 1970). Moreover, both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Ikuta et al. (United States Patent No. 6,475,575) or Eynon (United States Patent No. 6,524,754) or Smith (United States Patent No. 6,811,936) in view of Shu (United States Patent No. 6,842,228).

The Examiner asserted that "[i]t would have been obvious to one having ordinary skill in the art to take the teachings of Ikuta et al. or Eynon or Smith and combine them with the

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teachings of Shu in order to make the claimed invention because heating is typically used in the mask and semiconductor arts to separate layers."

Applicant respectfully traverse this rejection.

Applicant submits that a prima facie case of obviousness case has not been established by the combination in regard to claim 1.

First, the cited references fail to teach or suggest all the claim limitations. None of the references teaches or suggests step (b) of the process of the present application as claimed in claim 1, as amended. None of the references teaches or suggests the combination of steps (ii), (iii) and (iv) in a process of making hard pellicle. None of the references teaches or suggests step (iv): bonding of the pellicle mount frame to the second surface of the pellicle layer while the first surface of the pellicle layer is still bonded to the substrate. Moreover, the Examiner cited public knowledge in the rejection without citing a source of such public knowledge.

Second, none of the references contain any suggestion as to the motivation to make the combinations of references mentioned by the examiner.

Therefore, a prima facie obviousness case of claim 1 is not established by the various combinations of references mentioned by the Examiner.

Claims 2-23 are all dependent from claim 1, thus are not unpatentable over the cited references for the same reason.

IV. Conclusion

Applicant believes that the outstanding claims are patentable over the references and papers of record. Applicant respectfully requests reconsideration of the outstanding Office action and a prompt issuance of a notice of allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant additional time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

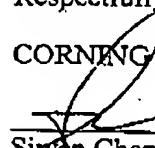
The undersigned attorney is granted limited recognition by the Office of Discipline and Enrollment of the USPTO to practice before the USPTO in capacity as an employee of Corning Incorporated.

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Please direct any questions or comments to the undersigned at (607) 248-1253.

Respectfully submitted,

 CORNING INCORPORATED

Date: Nov. 17, 2005

Siwen Chen
Limited Recognition No.: L0023
Corning Incorporated
Patent Department
Mail Stop SP-TI-03-1
Corning, NY 14831

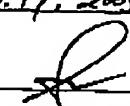
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